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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,869	08/30/2001	Pascal Arnaud	212527US0	7528
22850 7590 02/21/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER YU, GINA C	
			ART UNIT 1617	PAPER NUMBER
			NOTIFICATION DATE 02/21/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

Application No.

09/941,869

Applicant(s)

ARNAUD, PASCAL

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on October 30, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-27, 31-42, 44-51, 53-58, 60-78, 81-95, 101-103, 105-107 and 109-114 is/are pending in the application.
- 4a) Of the above claim(s) 53-57, 60 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-27, 31-42, 44-51, 58, 62-78, 81-95, 101-103, 105-107 and 109-114 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>October 30, 2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 26, 2007 has been entered.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 5-10, 31-35, 37-42, 44-51, 58, 62, 63, 65-70, 81-83, 85-95, 101-103, 105-106, 109-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nojima (EP 0548694 A1) in view of Mellul (US 5738841).**

The independent claims, claims 62 and 101, are directed to a transfer-resistant composition comprising (a) at least one non-volatile hydrocarbon-based oil with a molecular mass ranging from 230 to 420 g/Mol; (b) a silicone component consisting of one or more enlisted non-volatile silicone compound(s) in the claim; (c) from about 0.1-30 % by weight of the composition of an inert particulate phase; and (d) from 0 to about 5 % by weight of the total weight of the composition of a volatile oil.

Nojima teaches long-lasting, oil-based solid cosmetic compositions comprising one or more polyoxyalkylene modified silicones and one or more cosmetically

acceptable oils, pigments and fillers. See abstract; Tables. The reference teaches that incorporation of a volatile oil to a cosmetic composition reduces glossy appearance and stability of the composition. See p. 2, lines 10 – 22. See p. 4, lines 45 – 47 and lines 52 – 54 for the types of fillers and the amount used. See instant claims 41, 42-45. The reference further teaches that the long wear of the composition results due to the increase in viscosity of polyether-modified silicone in the composition upon the application on the skin, which holds the pigments more securely. See p. 5, lines 10 – 17. Thus it is inferred that no volatile oils are used in the Nojima transfer-resistant composition. See instant claims 62(d), 101(d), 111 and 112, which read on zero percent of a volatile oil.

In claims 50, 51, 93, and 94, the terms and phrase which are directed to the intended future use of the composition are not given patentable weight. See MPEP § 2111.02. The terms “make-up composition”, “foundation”, “blusher”, “eyeshadow”, “care base” “concealer product”, “eyeliner”, “mascara” denote the intended use of the claimed composition, rather than structural limitation of the composition. The terms “balm” and “lipstick” limit the invention of claim 1 to a solid composition. Nojima teaches in Example 1 a lipstick composition. See instant claims 48, 51, 94, and 95.

With respect to instant claims 103 and 107, it is noted that claims 62 and 101 recite a composition comprising a non-volatile silicone component as described in subpart (b) of the claims, and is open to include other silicone materials, subject to the limitation of (d), which limits the amount of any volatile oils present in the composition.

Thus, the presence of polyether-modified silicone in the Nojima composition does not affect the applicability of the reference.

While Nojima generally teaches using hydrocarbon oils, the prior art does not limit the specific molecular weight range of the oils as claimed by applicant.

Mellul teaches a cosmetic lipstick composition comprising 60 % octyldodecyl neopentanoate (non-volatile hydrocarbon oil, MW 382.67), 0.1 % diphenyldimethicone (non alkoxylated non-volatile silicone oil), 5% alkyldimethicone (non-alkoxylated non-volatile silicone), and 12 % pigments. See examples 5 and 6; instant claims 5-10, 62-69, 91-95, 101, 103, 107. The reference teaches using octyldodecyl neopentanoate in 0.5-99 % by weight. See col. 2, lines 30 – 33; instant claims 32-35, 82. The reference teaches that octyldodecyl neopentanoate is “an excellent agent for compatibilizing silicone-containing compounds with each other, has good thermal and chemical stability, and makes it possible to obtain compositions with much oilier texture on application than comparison with compositions of the prior art not containing it”. See col. 2, lines 11 – 21. The reference further teaches that the ester has dispersant properties with respect to powders, and makes it possible to make a homogeneous dispersion. See col. 2, lines 21 – 24. The reference also teaches using at least one silicone-containing compound such as polymethylsiloxanes, alkyldimethicone, polyphenylmethylsiloxane, more specifically, phenyldimethicone and phenyltrimethicone; and silicones modified with aliphatic and/or aromatic groups, which optionally contain fluorine, or with functional groups such as hydroxyl, thiol and/or amine

groups. See col. 2, lines 47- col. 3, line 5; see Example 3. See instant claims 103, 105, 107, 109, and 110.

Although Mellul mentions the functional equivalency of the above non-volatile silicone oils with cyclomethicone, which is a volatile oil, Nojima teaches that volatile oils reduce the glossiness and stability of the composition. Thus it is obvious that a skilled artisan would have been motivated to select the non-volatile silicone oils over volatile oils. See instant claims 103, 105, 107, and 109-112.

It would have been obvious to one of ordinary skill in the art at the time the invention was made modify the lipstick composition of Nojima by substituting the hydrocarbon oil in the formula with octyldodecyl neopentanoate as motivated by Mellul because the latter teaches that the ester is comparable with silicone, has good thermal and chemical stability, and provides homogenous dispersion of pigments and oily texture on application. The skilled artisan would have had a reasonable expectation of successfully producing a stable lipstick composition because Nojima teaches to use hydrocarbon oil.

**Claims 2-4, 11-19, 21-27, 36, 64, 71, 72, 74-78, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nojima and Mellul as applied to claims 5-10, 31-35, 37-42, 44-51, 58, 62, 63, 65-70, 81-83, 85-95, 101-103, 105-107, 109-112 above, and further in view of Jacks et al. (US 5690918).**

Nojima and Mellul fail to teach non-volatile hydrocarbon oil having the MW limitation of instant claims 2-4 and the dispersant of the instant claims 11-19, 21-23, 36, 71, 72, 74-79, 84.

Jacks teaches that it is well known in cosmetic art that isononyl isononanoate (non volatile hydrocarbon oil, MW 284.48 g/mole) is used to make lipstick compositions. See Example 2; instant claims 2-4. The reference also teaches using 10.34 % of diisoarachidyl dilinoleate (dispersant) in the lipstick formulation. See Example 2. See instant claims 11-19, 21-23, 36, 71, 72, 74-79, 84.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the lipstick composition of the combined references by substituting octyldodecyl neopentanoate and a diisoarachidyl dilinoleate with isononyl isononanoate as motivated by Jacks because the references are directed to lipstick formulations and Nojima and Jacks teach that these hydrocarbon oils are well known functional equivalents in lipstick art. The skilled artisan would have had a reasonable expectation of successfully producing a lipstick composition with similar effectiveness.

**Claims 20 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nojima and Mellul as applied to claims 5-10, 31-35, 37-42, 44-51, 58, 62, 63, 65-70, 81-83, 85-95, 101-103, 105-107, 109-112 as above, and further in view of JP 63119412.**

Nojima and Mellul, discussed above, do not teach poly(hydroxyl-12) stearic acid.

JP 63119412 abstract teaches 12-hydroxystearic acids is well known in lipstick art, and that the compositions having 12-hydroxystearic acid along with polyhydric alcohol esters of rosin, fatty acids with polyhydric alcohol gives improved luster and good dispersion of color. See abstract.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of conventional lipstick agents. It would follow that the recited claims define prima facie obvious subject matter.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have added 12-hydroxystearic acid as motivated by JP 63119412 because of the expectation of successfully producing a lipstick composition with improved luster and good dispersion of color, as taught by the Japanese abstract.

**Claims 2-5, 35, 37-42, 44, 48, 50 51, 58, 62, 64, 83, 85-89, 93, 94, 101, 103, 106, 107, 109, 110-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brieva (US 5800816).**

Brieva teaches cosmetic compositions with improved transfer resistance comprising a) from about 0.1-60 % by weight of trimethylated silica; b) from about 0.1-60 % by weight of a volatile solvent having a viscosity of 0.5-100 centipose at 25 c; and c) 0.1-60 % by weight of a nonvolatile component having a viscosity of 200-1000000 centipoise at 25 C; and d) 0.1-80 % of a cosmetically acceptable carrier. See abstract. Example 2 illustrates a mascara composition comprising oleyl alcohol (MW 268), Dow Corning 2-

0747 (trimethylsiloxy silicate in a volatile silicone oil), 4.5 % of silica (inert particulate phase).

The difference between the prior art and the present invention is that the present invention requires 2-phenylethyl trimethylsiloxy silicates, and the amount of the volatile oil is limited to about 5 % and about 2 %.

The reference teaches the other types of non-volatile silicone compounds of (b), such as fluorosilicones, phenyl trimethicone, polydimethylsiloxanes. See col. 3, lines 50 – col. 4, line 9. Additionally adding these non-volatile silicone compounds according to the teaching of the reference would have been obvious.

Since Brieva teaches that about Dow Corning 2-0747 contains approximately equal amount of trimethylsiloxy silicate and volatile silicone oils, about 7.5 % of the volatile oil(s) is present in the formulation of Example 2. It is viewed that the difference between “about 5” and about 7.5 is obviously within an overlapping range. Furthermore, the reference teaches the lower limit of the volatile solvent is 0.1 % by weight, thus it is obvious that lower amount of the Dow Corning 2-0747 would have been envisioned.

#### ***Oath/Declaration***

Declaration filed under 37 C.F.R. 132 on October 30, 2007 has been fully considered but does not place the application in allowable condition. The declaration indicates that alkoxyated silicone compounds as used in Nojima are non-volatile. The finding does not overcome the obviousness rejection because claims 62 and 101 do not exclude the presence of alkoxyated silicone. See Response to Arguments below.

***Response to Arguments***

Applicant's arguments with respect to claims 2-27, 31-42, 44-51, 58, 62-78, 81-95, 101-103, 105-107, and 109-114 have been considered but are moot in view of the new ground(s) of rejection.

Applicant alleges that the Markush language of claim 101 excludes the alkoxyated silicone of Nojima. Applicant asserts that the Markush language in claim 101 (b) limits the only non-volatile silicone compounds which may be present in the claimed compositions to those recited in the claim. However, the Markush language only limits group (b), the claimed composition itself is open to ***comprise*** any components other than the limitations of (a)-(d).

Examiner disagrees with the applicant's statement that Mellul teaches away from combining the reference with Nojima. Mellul merely serves as an evidence of documented advantages of the applicants' cosmetic oil, octyldodecyl neopentanoate as used in cosmetic compositions. There is no teaching or suggestion, either explicitly or implicitly, that the cosmetic benefits of the oil would not be realized simply because it is combined with alkoxyated silicones or inert particulate phase of Nojima.

Similarly, there is no teaching or suggestion in the Jacks reference for a reasonable routineer to believe that the claimed hydrocarbon oil is effective only in the presence of excessive amount of volatile oil. Applicant alleges that the presence of 0.1-60 % of volatile oil in the Jacks reference does not enable the present invention. While applicant describe the prior art range of volatile oil as a "large amount", it is respectfully

pointed out that the range of from 0.1 up to about 5 % by weight of the oil, as claimed by applicant, is also encompassed by the prior art.

Applicant asserts that a skilled artisan would not have been motivated to make a transfer-resistant composition in view of Mellul, citing that the reference is related to a homogeneous compositions containing non-alkoxylated silicones. However, it is viewed that the teaching of the advantageous properties of octyldodecyl neopentanoate from Mellul provides an objective motivation to use this compound to modify and modify the Nojima invention.

Regarding the Brieva reference, applicant argues that the reference lacks sufficient guidance to a routineer how to make a transfer-resistant composition without using a substantial amount of volatile oil. Applicant also asserts that the reference should suggest which non-volatile oils could be used to produce a transfer-resistant composition and whether any non-volatile oils could be used at all. Examiner respectfully points out that the argument is not commensurate with the scope of the present invention, since the present invention is merely limited by components and their amounts, which are rendered obvious in view of the prior art reference. As discussed with respect to the Jacks reference, the range of from 0.1 up to about 5 % by weight of the oil, as claimed by applicant, is also encompassed by the prior art. In this case, examiner had specifically pointed out in the rejection that about 7.5 % of a volatile oil, as used in the prior art, is in proximity with the claimed range that it would have been obvious to a skilled artisan to discover an optimal weight amount of the volatile oil.

***Conclusion***

Application/Control Number:  
09/941,869  
Art Unit: 1617

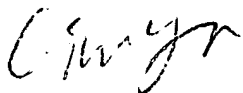
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No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gina C. Yu  
Patent Examiner